

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: James Malcolm Vignoles et al.

Application No.: 09/938,489

Group No.: 2137

Filed: August 27, 2001

Examiner: Pyzocha, M.

For: UPDATE STATUS ALERTING FOR A MALWARE SCANNER

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**NOTICE OF APPEAL FROM THE PRIMARY EXAMINER
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES
(37 C.F.R. § 41.31)**

Applicant hereby appeals to the Board from the decision of the Primary Examiner, mailed January 9, 2007, for a second time rejecting claims 1-2, 9-14, 21-26, 33-37.

1. STATUS OF APPLICANT

This application is on behalf of other than a small entity.

2. FEE FOR FILING NOTICE OF APPEAL

Pursuant to 37 C.F.R. § 41.20(b)(1), the fee for the Notice of Appeal is:

Other than a small entity	\$500.00
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Notice of Appeal fee due	\$500.00
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3. EXTENSION OF TERM

Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

4. TOTAL FEE DUE

The total fee due is:

Notice of Appeal fee	\$500.00
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TOTAL FEE DUE	\$500.00
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5. FEE PAYMENT

Authorization is hereby made to charge the amount of \$500.00 to Deposit Account No. 50-1351 (Order No. NAI1P495).

Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

A duplicate of this transmittal is attached.

6. FEE DEFICIENCY

If any additional extension and/or fee is required, and if any additional fee for claims is required, charge Deposit Account No. 50-1351 (Order No. NAI1P495).

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/KEVINZILKA/

Signature of Practitioner
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) NAI1P495/01.018.01	
I hereby certify that this correspondence is being e-filed with the USPTO on <u>March 9, 2007</u> Signature <u>/Erica L. Farlow/</u> Typed or printed name <u>Erica L. Farlow</u>	Application Number 09/938,489		Filed 08/27/2001
	First Named Inventor James Malcolm Vignoles		
	Art Unit 2137		Examiner Pyzocha, M.
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. 41,429 Registration number _____ <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ </div> <div style="width: 45%; text-align: center;"> <u>/KEVINZILKA/</u> _____ Signature Kevin J. Zilka _____ Typed or printed name (408) 971-2573 _____ Telephone number March 9, 2007 _____ Date </div> </div>			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

REMARKS

The Examiner has objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Examiner has asserted that “[e]ach independent claim has been amended to include at least the phrase ‘tangible computer readable medium’” and that “nowhere in the specification is this phrase disclosed.” Applicant disagrees and respectfully asserts that Page 11, lines 13-15 of the specification disclose “computer program instructions that may be stored in one or more of the random access memory 204, the read only memory 206 and the hard disk drive 210” (emphasis added), all of which are computer readable mediums.

The Examiner has rejected Claims 1-2, 9-14, 21-26, and 33-37 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner has again asserted that “[e]ach independent claim has been amended to include at least the phrase ‘tangible computer readable medium’” and that “nowhere in the specification is this phrase disclosed.” Applicant again disagrees and respectfully asserts that Page 11, lines 13-15 of the specification disclose “computer program instructions that may be stored in one or more of the random access memory 204, the read only memory 206 and the hard disk drive 210” (emphasis added), all of which are computer readable mediums.

In the Office Action mailed 01/09/07, the Examiner has responded to applicant’s above argument by arguing that “Claims 25-26 and 33-37 purport to be apparatus claims, but appear to be lacking an essential element under 112, 2nd, to support the preamble and make them apparatus claims” (see page 5, paragraph 1 of the Office Action). Applicant assumes that this argument by the Examiner refers to the above 35 U.S.C. 112, first paragraph rejection, which is addressed above.

The Examiner has rejected Claims 1-2, 9-14, 21-26, and 33-37 under 35 U.S.C. 101 as being directed towards non-statutory subject matter. Applicant respectfully disagrees with such rejection.

With respect to Claims 1, 2, and 9-12, the Examiner argues that the “computer program product” as claimed by applicant “is just the software piece and fails to include the physical article or object as the medium which establishes the statutory category.” Applicant disagrees and respectfully points out that independent Claim 1 includes “computer program product embodied on a tangible computer readable medium” (emphasis added), as claimed.

In addition, the Examiner has argued that Claims 1-2, 9-14, 21-26, and 33-37 fail to produce a useful, concrete, and tangible result in the instance when the update status of the current malware scanner matches the update status of the previous malware scanner. Specifically, the Examiner has argued that the Examiner “has reviewed the final result achieved for each condition covered, both those actually recited and those covered and not recited” and concludes that “[i]f any [condition] fail[s] to be a useful, concrete, and tangible result, then the claims are properly rejected under 35 U.S.C. 101.” The Examiner goes on to argue that “there is no useful, concrete, and tangible result when the update status of the previous scanner is the same as the update status of the current scanner.”

In addition, in the Office Action mailed 1/09/07, the Examiner has again reiterated that “there is no useful, concrete, and tangible result when the update status of the previous scanner is the same as the update status of the current scanner” and that “[w]hen these statuses are the same the only steps being performed are reading and comparing and clearly these do not result in a useful, concrete, and tangible result.”

Applicant respectfully disagrees. After careful review of 35 U.S.C. 101 and the relevant sections of the MPEP, applicant fails to find any support for the Examiner’s assertion that “[i]f any [condition] fail[s] to be a useful, concrete, and tangible result, [whether or not recited in the claims,] then the claims are properly rejected under 35 U.S.C. 101” (emphasis added). Further, applicant respectfully asserts that the claims are not limited to a situation where “the update status of the previous scanner is the same as

the update status of the current scanner,” as noted by the Examiner, and thus a rejection based on such language is clearly improper.

Applicant again points out that each of the independent claims do provide a useful, concrete and tangible result. For example, applicant claims, in part, “alert issuing logic operable if said update status of said current malware scanner does not match said update status of said previous malware scanner to issue an update status alert indicative of an out-of-date update status for whichever one of said current malware scanner and said previous malware scanner has a most out-of-date update status...change logging logic operable to log changes to said update status field to create a change history in an update status tracking database to enable identification of weaknesses within update status management based on the change history...wherein, if said current malware scanner has a less out-of-date update status than said previous malware scanner, then said update status field associated with said computer file is changed to correspond to said current malware scanner... wherein, if there is no said update status associated with said computer file at a first malware scanning, then said update status field is generated and associated with said computer file, and said update status tracking database is updated” (see the same or similar, but not necessarily identical language in each of the independent claims-emphasis added). In fact, in independent Claim 1 applicant claims a “computer program product embodied on a tangible computer readable medium operable to control a computer to issue an alert for an out-of-date update status of a malware scanner” (emphasis added), which clearly is a useful, concrete and tangible result.

Therefore, based on the limitations in Claim 1, as highlighted above, it is clear that a useful, concrete and tangible result is evident. In addition, for reasons at least substantially similar (but not necessarily identical) to those above, applicant respectfully asserts that independent Claims 13 and 25 also produce a useful, concrete and tangible result.

To this end, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.